

## REMARKS

After entry of the Amendment of July 22, 2003, claims 2-19 are pending in the application. The following remarks address the issues raised in the Advisory Action mailed on August 6, 2003.

### NEW MATTER

The Examiner indicated in the Advisory Action that potentially, there would be new matter introduced by the amendment in which Applicant changed the dependency of the claims to depend on amended claim 12. Previously these claims depended directly or indirectly on claim 1 which is now cancelled. Applicant respectfully disagrees.

By the previous amendment, Applicant rewrote claim 12 (which was a dependent claim in the original application) in independent form to incorporate the limitations from the base/intervening claim from which it depended (i.e., claim 12 was rewritten to expressly include the limitations of claim 1 which it already inherently included by virtue of its original dependency from claim 1). Applicant then amended the remaining independent claims to depend (directly or indirectly) from claim 12.

The Advisory Action alleges that Applicant's specification, which refers to claim 1, would have to be amended to remove the reference to claim 1 since claim 1 is now cancelled. However, Applicant presumes claim 12 (the only remaining independent claim in the application) would be renumbered as claim 1 upon issuance and thus the allegation does not appear to have merit.

Further, the Advisory Action discusses the multiple embodiments disclosed in the instant specification and essentially alleges that since the dependent claims (i.e., claims 2-

11 and 13-19) now include the additional limitation of claim 12 (previously they did not depend from claim 12), Applicant must show the express location of this description where this embodiment is taught. Respectfully, this is not required of Applicant.

The test for whether new matter is included by an Applicant's amendment to a claim is whether [the amendment] recites elements without support in the original disclosure *Waldemar Link, GmbH & Co. v. Osteonics Corp.*, F.3d 556, 559 (Fed. Cir. 1994). In rejecting Applicant's claims for failing to meet the written description requirement (claims are rejected as having new matter introduced into the claims), the Examiner has the initial burden of showing why a person skilled in the art would not recognize in applicant's disclosure a description of the invention defined by the claims *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976).

Applicant however submits that none of the pending claims have any new elements since all elements were included in the original claims of the application. Furthermore, the skilled artisan would realize that combinations of the various embodiments disclosed in the application would be possible, particularly when Applicant expressly indicates in the application that such modifications are possible. By way of example, Applicant directs the Examiner to page 8 lines 17-20 of the instant specification where it is expressly stated that the "invention may be realized in various ways" and that "the invention and its embodiments are therefore not restricted to the examples described [in the specification]." Applicant submits the skilled artisan would readily recognize the possibility of combining the various elements of the original claims.

Notwithstanding, if the Examiner alleges Applicant's amendments include new matter, the Examiner is respectfully requested to cite legal precedence supporting this position that merely amending the dependencies of the claims constitutes new matter.

#### INDEFINITENESS

The Advisory Action indicates that Applicant's claims are still considered indefinite since "Applicant has yet to clearly point out the exact term 'overall service situation' in applicant's specification."

In response, Applicant notes that there is no legal or regulatory requirement for an applicant to point out or define in its specification the meaning of each word in a claim. Under 35 U.S.C. § 112, second paragraph, the essential inquiry is whether one of ordinary skill in the art would understand the meaning of the term in question after considering the application disclosure and the teachings of the prior art.

A "service situation" is referenced throughout the specification and relates to the level of service in the packet radio network. The "overall service situation" is clarified for the Examiner using the following example:

Ordinarily a user or terminal can observe that he is receiving data at a certain rate (e.g., 10 Kbs), which is considered to be slow. The user has no way of knowing whether the slow speed is due to delays in the overall network or with only the other end of the connection (such as a server). If the user, observing a 10 Kbs data transfer speed, can be informed by the network that the overall service situation, such as the average speed of data transfer for several network users, is higher, for example 50 Kbs, the user realizes that the slow speed is specific to his connection and re-negotiating to a higher QoS class

is not likely to improve the situation since it is the end connection (i.e., the server) that is causing reduced speed as opposed to the network switches.

Accordingly, the "overall service situation" of a packet radio network is just as the plain meaning of the phrase indicates, the overall, as opposed to localized, performance level of service. Based on the forgoing, Applicant respectfully submits this term complies with all requirements of 35 U.S.C. § 112 second paragraph

In the event that there are any fees due with respect to the filing of this paper, please charge Counsel's Deposit Account No. 50-2222.

Respectfully submitted,



Kevin F. Turner  
Registration No. 43,437

**Customer No. 32294**  
SQUIRE, SANDERS & DEMPSEY LLP  
8000 Tower Crescent Drive, 14<sup>th</sup> Floor  
Tysons Corner, Virginia 22182-2700  
Tel: (703) 720-7800  
Fax: (703) 720-7802

KFT/SAW/lis